

REMARKS

Reconsideration of the present application is respectfully requested in view of the following comments.

1. Amendment of claim 1

Claim 1 is presently amended to include the features of claim 12. Acceptance of this amendment is respectfully requested in the next Office communication.

2. Rejection of Claims 1-9, 11, 13-14 and 16 under 35 U.S.C. § 103(a) as being Obvious over U.S. Patent 5,991,739 (Cupps et al.) in View of U.S. Patent 6,539,080 (Bruce et al.)

Claims 1-9, 11, 13-14 and 16 currently stand rejected as being obvious over the disclosure of Cupps et al. in view of the Bruce et al. disclosure. Applicant respectfully traverses this rejection on the basis that the Cupps et al. and Bruce et al. disclosures, whether considered collectively or individually, fail to describe or suggest a method for searching information on the Internet, as presently recited in claim 1 of the present application. Claims 2-9, 11, 13-14 and 16 are thus patentable based on their dependency from claim 1 and their individually recited features.

It will be noted that the following remarks include some of those in the reply of July 23, 2004 in response to the Office Action of May 20, 2004. Many of the previous remarks are resubmitted since not all of these remarks have been particularly addressed by the Examiner, especially the remarks concerning the improper combination of the Cupps et al. and Bruce et al. disclosures. Additional remarks are also presented regarding the comments provided by the Examiner in the Advisory Action of August 25, 2004, of which the Applicant maintains are incorrect interpretations of the Bruce et al. disclosure.

Lastly, it will be pointed out that claim 1 has been amended to include the subject matter of original claim 12. It will be noted that the combination of the Cupps et al. and Bruce et al. disclosures were combined with the disclosure of Madnick et al. to reject claim 12. As discussed in section 4 of this reply, Applicant maintains that the Cupps et al. and Bruce et al. disclosures, whether combined or not combined with the teachings of Madnick et al., fail to describe basic features of claim 1.

a. Claim 1 of the Present Application

Claim 1 generally relates to a method for searching information on the internet. The method comprises using at least one search assistant to help a user when searching for information on the internet, wherein such human search assistant is human and a specialist in searching on the internet.

In addition, claim 1 further recites that the human search assistant reformulates a first information request of the user into an adapted information request associated with the first information request and applies the adapted information request on at least one search robot for accessing information related to the first information request.

b. Cupps et al. Disclosure

In the Action, the Background of the Invention in the disclosure of Cupps et al. is used as a basis for the rejection of the above-identified claims. Applicant submits that there is simply no disclosure or suggestion in the disclosure of Cupps et al. of using "a human search assistant" to assist a user when searching on the Internet. While the Action indicates that the PizzaNet described by the Cupps et al. disclosure is "represented as a human search assistant," the Cupps et al. disclosure makes no such description, whether implicitly or explicitly. Instead, the PizzaNet is described along with other Internet services that provide customers with access to menus for products that can be ordered online (col. 1, lines 9-12). While customers enter personal information to obtain menus in a specific geographical area, such

information is apparently used in an automated process whereby the PizzaNet then provides a menus list of participating pizza restaurants within the specific geographical area. *Nowhere is there any disclosure or suggestion of a human deliberately providing assistance in providing such list of menus.*

The Cupps et al. disclosure makes it known that a shortcoming of the PizzaNet is that its primary method of communication with a restaurant is through a facsimile machine (col. 2, lines 9-11). Moreover, once the order is made on the Internet, subsequent communication between a customer and the delivery system is performed via telephone calls (col. 2, lines 14-16). At this stage in the ordering process, however, the customer has presumably completed use of the PizzaNet by having already selected a restaurant and ordered food by such restaurant.

In the PizzaNet system, it is left to the user to search which restaurants are desired. The user of the PizzaNet system can review each menu to determine what is desired. If a live operator were used, it is unclear from the comments in the Action what such operator would do other than replace the PizzaNet system itself.

These observations beg the question how it may be asserted in the Office Action that the PizzaNet is represented as a human search assistant when the only human involvement in using the PizzaNet is the actual customer entering personal information, selecting from a list of menus based on the entered personal information, and ordering from a selected menu. Since there is no disclosure of a human providing assistance to a customer using the PizzaNet in making an order via the Internet, it bewilders the Applicant how the Cupps et al. disclosure can be construed to teach such a proposition.

When properly interpreted, the PizzaNet described by Cupps et al. merely is an automated Internet search tool that permits food products to be ordered online. Indeed, the Cupps et al. disclosure does not discuss or show a human search assistant, but instead briefly describes an automated search and ordering system.

Thus, even an artisan of ordinary skill must guess about how exactly the PizzaNet system would incorporate a human search assistant and why a human search assistant would even be desirable if everything that the PizzaNet system provides is automated. In fact, the Cupps et al. disclosure makes no suggestion of any kind about the suitability for a human search assistant. About the most that can be said for the Cupps et al. patent is that it is silent in respect to a human search assistant. However, it is well understood that a negative pregnant is not enough to show anticipation or obviousness.

Thus, the Cupps et al. disclosure does not describe or suggest the method of claim 1 of the present application.

c. Bruce et al. Disclosure

In the Action, the disclosure of Bruce et al. has been proffered to make up for the shortcomings of the Cupps et al. disclosure. Namely, the Action fully admits that the Cupps et al. disclosure fails to teach the provision of claim 1 of the present application in that "at least one search assistant is human and a specialist in searching on the Internet." Applicant respectfully disagrees that the Bruce et al. disclosure furnishes a description or suggestion that when combined with the disclosure of Cupps et al. would tend to motivate one skilled in the art to execute or devise the method recited in claim 1 of the present application.

More specifically, the Bruce et al. disclosure describes a method and system for providing a telephone caller information assistance, such as driving directions. To obtain the assistance, the caller places a telephone call to access the system. After obtaining street route driving instructions, the call can be transferred to an audio box having an interactive user interface capable of replaying the desired information to a caller.

Nowhere in the Bruce et al. disclosure is there a description or suggestion of an operator assisting a user in searching information on the Internet. While it is true

that the caller may obtain the driving instructions in different ways from receiving them over a telephone, the Bruce et al. disclosure only describes a caller initiating a demand for instructions by calling an operator.

The Bruce et al. disclosure makes it abundantly clear that the method and system disclosed therein is distinguished in that it provides instruction to a caller who does not have ready access to the Internet (col. 1, lines 25-30). For example, the Bruce et al. disclosure states that route mapping software is of little assistance in a situation wherein a traveler becomes lost during his trip and does not have ready access to the Internet. The method of the Bruce et al. disclosure thus provides a solution for drivers that do not have ready access to the Internet.

This observation begs the question of how can the Bruce et al. disclosure be construed to teach Internet searching assistance when it is presumed that users (i.e., drivers) participating in the method of the Bruce et al. disclosure do not have ready access to the Internet.

In the Advisory Action, the Examiner counters the argument that the Bruce et al. disclosure does not teach a human search assistant on the Internet. More particularly, the Examiner indicates that the Bruce et al. disclosure describes human search assistance in col. 8, lines 30-37. Applicant respectfully submits that the col. 8, lines 30-37 does not provide support for the Examiner's argument.

It is made quite apparent in the Bruce et al. disclosure that directional assistance for a user is made via a database that does not form a part of the Internet. This is evident in view of FIG. 1 of the Bruce et al. disclosure wherein an operator has access to a database 20 that comprises a directory listing database 22, a GEO TN database 23, and a routing database 24 (col. 3, lines 26-28). There is no suggestion to indicate that these databases are part of the Internet. The section provided by the Examiner as support for the notion that the method of Bruce et al. provides Internet searching assistance is simply incorrect.

It is respectfully requested that the Examiner make a showing that the database 20 of the Bruce et al. disclosure is or forms part of the Internet, as asserted in the Advisory Action.

d. Combination of the Cupps et al. and Bruce et al. Disclosures

Applicant submits that the Cupps et al. and Bruce et al. disclosures, whether considered collectively or individually, fail to disclose or suggest each and every feature recited in claim 1 of the present application. For the reasons discussed below, Applicant submits that the combination of the Cupps et al. and Bruce et al. disclosures fail to render claim 1 unpatentable.

To establish obviousness under 35 U.S.C. § 103(a), differences between the subject matter sought to be patented and the prior art reference are such that the subject matter as a whole would have been obvious to one skilled in the art at the time of the invention. Accordingly, in making an assessment of differences, section 103 specifically requires consideration of the claimed invention as a whole guided by the accepted wisdom at the time the invention was made. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275, 69 U.S.P.Q.2d 1686, 1689.

Identification of each element of a claimed invention in prior art references is insufficient to defeat patentability of the whole claimed invention. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching to select and combine the references relied on as evidence of obviousness. *In re Lee*, 277 F.3d 1338, 1342-43, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (citing *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001)).

In making a rejection based on obviousness, particular findings and specific reasons must be provided as to why a skilled artisan would have been motivated to select references and to combine them to render a claimed invention obvious. See

In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); See also *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). Evidence of the motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Whether an express or implicit showing is relied upon, particular findings related thereto must be provided therewith. When general knowledge is relied upon to negate patentability, that knowledge must be articulated in the record and cannot be resolved on "subjective belief and unknown authority." *Lee*, 277 F.3d at 1342-1345, 61 U.S.P.Q.2d at 1433-35.

The Cupps et al. disclosure describes an automated Internet search and ordering system and the PizzaNet system has been identified as a system akin to the system of claim 1 of the present application. On the other hand, the Bruce et al. disclosure describes a method and system for providing directions via a telephone. The Action appears to select the telephone system of the Bruce et al. disclosure, and proposes to incorporate the system of Bruce et al. with the PizzaNet described by the Cupps et al disclosure.

There is no evidence provided in the Cupps et al. disclosure as to the desirability of employing an operator to assist in searching for a restaurant in the PizzaNet system. Indeed, if an operator were used to search for a restaurant in accordance with the PizzaNet system in the Cupps et al. disclosure, there would likely be no need for the PizzaNet system since the operator would effectively perform the same task.

The Action asserts that in view of the teachings of the Cupps et al. and Bruce et al. disclosures, one of ordinary skill in the art would have been motivated to make the method of claim 1 of the present application. The rationale for the motivation

proffered by the Action is that a live operator as described in the system of the Bruce et al. disclosure would have saved time for a user of the PizzaNet system described in the Cupps et al. disclosure. The Examiner's rationale does not find any support in the prior art references themselves, as they are not directed to problems related to time economy. Also, the Examiner fails to acknowledge that if a live operator were used in conjunction with the PizzaNet system described in the Cupps et al. disclosure, the live operator would obviate the need for the PizzaNet system since this system takes information from a user and automatically provides a list of restaurants local to the user and access to menus of such restaurants.

The statements in the Action regarding the motivation or desirability to combine the Cupps et al. and Bruce et al. disclosures are conclusory in nature and fail to address the adequacy of motivation to combine these references. The rationale in the Action for combining the Cupps et al. and Bruce et al. disclosures is not based on objective evidence, but is instead grounded on subjective belief and unknown authority. Thus, the Action has failed to provide requisite findings of motivation to modify the Internet search and ordering system described in the Cupps et al. disclosure with the teachings of the Bruce et al. disclosure. Moreover, the Action fails to explain the reasoning by which the findings are deemed to support the Examiner's conclusion. See e.g., *Lee*, 277 F.3d at 1345, 61 U.S.P.Q. at 1434.

It is therefore submitted that the motivations provided in the Action to combine the teachings of the Cupps et al. and Bruce et al. disclosures are not taken from the prior art references themselves, but instead appear to be taken from Applicant's disclosure or are merely fabricated.

The Examiner is respectfully requested to present evidence within the Cupps et al., and Bruce et al. disclosures themselves to support the assertion that these references may be combined to devise the method of amended claim 1 of the present application. Thus, until such appropriate evidence and justification thereof is

presented, Applicant maintains that this rejection does not meet the requirements of 35 U.S.C. § 103.

Accordingly, in view of these observations, Applicant respectfully requests withdrawal of the rejection of claims 1-9, 11, 13-14 and 16.

3. Rejection of Claims 10 and 15 under 35 U.S.C. § 103(a) as Being Obvious over U.S. Patent 5,991,739 (Cupps et al.) in view of U.S. 6,569,080 (Bruce et al.) and Further in View of U.S. Patent 5,898,594 (Leason et al.)

Claims 10 and 15 presently stand rejected in view of the combination of the Cupps et al., Bruce et al. and Leason et al. disclosures. Claims 10 and 15 depend from claim 1 which was distinguished above in view of the combination of the Cupps et al. and Bruce et al. disclosures. It will be further noted that claim 1 also now includes the subject matter of original claim 12.

As evidenced by the Examiner's failure to reject claim 12 by the combination of the Cupps et al., Bruce et al. and Leason et al. disclosures, it is readily evident that claim 1 as presently amended is patentable over this proposed combination. Accordingly, withdrawal of this rejection is respectfully requested.

4. Rejection of Claim 12 under 35 U.S.C. § 103(a) as Being Obvious over U.S. Patent 5,991,739 (Cupps et al.) in View of U.S. 6,569,080 (Bruce et al.) and Further in View of U.S. Patent 5,913,214 (Madnick)

Claim 12 presently stand rejected in view of the combination of the Cupps et al., Bruce et al. and Madnick et al. disclosures. As noted above, the subject matter of claim 12 has been incorporated into claim 1, which was distinguished above in view of the combination of the Cupps et al. and Bruce et al. disclosures.

Applicant respectfully submits that the Madnick et al. disclosure fails to make up for the shortcomings discussed above in reference to the Cupps et al. and Bruce et al. disclosures. More specifically, the disclosure of Madnick et al. fails to provide

any teaching that would provide motivation to include a human search assistant for assisting a user to search for information on the Internet.

The system of Madnick et al. fails to provide specialized human search assistance and thus cannot interpret any information found on the Internet as a human search assistant can in claim 1 of the pending application. Claim 1, as amended with the subject matter of claim 12, provides that the human search assistant reformulates a first information request into an adapted information request which is applied to a search robot. Nowhere in the Madnick et al. disclosure is there is description or suggestion of a human search assistant reformulating a search request.

There is no suggestion in the Cupps et al., Bruce et al. and Madnick et al. disclosures that would motivate a skilled artisan to combine these references to devise the method according to amended claim 1 of the present application. Moreover, the Examiner has failed to proffer any evidence, as mandated by case law, within the cited disclosures themselves of any evidence that would motivate a skilled artisan to combine these disclosures to make the recited method of claim 1. Instead, the Examiner baldly asserts that it would be obvious to a skilled artisan to combine the teachings of the proffered disclosures based on what appears to be speculation on behalf of the Examiner rather than grounded evidence within the references themselves. Thus, the combination of the Cupps et al., Bruce et al. and Madnick et al. disclosures seems to be based solely on subjective belief and unknown authority that has been considered as impermissible justification for a rejection under 35 U.S.C. § 103.

The Examiner is respectfully requested to present evidence within the Cupps et al., Bruce et al. and Madnick et al. disclosures themselves to support the assertion that these references may be combined to devise the method of amended claim 1 of the present application.

Application No.: 09/922,811
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Accordingly, the Cupps et al., Bruce et al. and Madnick et al. disclosures, whether considered collectively or individually, fail to disclose or suggest the features recited in claim 1 of the present application. Withdrawal of this rejection is respectfully requested.

5. Conclusion

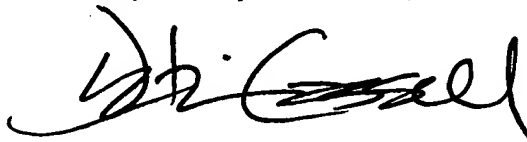
In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that claims 1-11, 13-16 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's Attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written over a horizontal line.

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